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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,786	08/01/2001	Kenneth C. Hart	134-001USA000	4021

7590

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EXAMINER

PASCUA, JES F

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 10/16/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,786

Applicant(s)

HART, KENNETH C. CN

Examiner

Jes F. Pascua

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- ↳ Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "conical shape" (claim 58) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 38-40, 48-50, 59, 62-64 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 38-40 and 59, it is unclear if applicant is positively reciting the "information". Independent claims 37 and 56 recite the "information" using the functional language "for printing information". Whereas dependent claims 38-40 and 59 recite positive structure for the "information". Clarification of the claims is requested. For the purposes of examination, the "information" will be considered as intended use that imparts no structural limitation to the claims.

In claims 48-50 and 62-64, it is unclear if "said flexible plastic membrane" refers to the "inflatable air chambers" or the membrane that "surrounds the at least one sidewall".

Claim 69 is confusing because, in its chain of dependency, it depends from claim 55 which recites the same limitation.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37, 41, 46, 47, 51, 56, 58, 60, 61 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Garbuzov.

Garbuzov discloses an inflatable container comprising a sidewall formed from a plastic membrane having inflatable air chambers, a flexible plastic membrane that is removably disposed on the exterior of the sidewall and an inflatable lid.

The recitation "inflatable cooler" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). The inflatable nature

of the sidewall and lid of Garbuzov renders them inherently capable of acting as a thermal insulating barrier for contents of the inflatable container.

The flexible membrane surrounding the exterior of the sidewall is inherently "suitable for printing information thereon". A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the flexible membrane inherently "provides support for stress normal to the sidewall" since Garbuzov shows the flexible membrane being "shaped such that it surrounds the at least one sidewall".

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 38-40 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garbuzov in view of Brown.

Garbuzov discloses the claimed invention except for the flexible plastic membrane being printed with information comprising one of text, graphics and logos. Brown teaches that it is known in the art to provide printed matter on an analogous flexible membrane. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the flexible plastic membrane of Garbuzov with printed matter of Brown, in order to convey information to the user of the inflatable container. Furthermore, the printed matter disclosed by Brown is considered to be broad enough in scope to comprise one of text, graphics and logos.

Regarding claim 39, Garbuzov and Brown disclose the claimed invention, as discussed above, except for the printing silk-screened or vinyl graphically printed. It would have been an obvious matter of design choice to silk-screen or vinyl graphically print the information of Brown, since applicant has not disclosed that silk-screening or vinyl graphic printing solves any stated problem or is for any particular purpose and it appears that the Brown invention would perform equally well with the information being silk-screened or vinyl graphically printed.

8. Claims 42, 44, 45 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garbuzov.

Garbuzov discloses the claimed invention except for the container having a plurality of sidewalls, a bottom wall or a pyramid shape. It would have been an obvious matter of design choice to make the container Garbuzov with a plurality of sidewalls, a bottom wall or a pyramid shape or whatever form or shape was desired or expedient. A

change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding claim 44, the lid of Garbuzov is considered to be a "smooth top" to the same degree as claimed. Furthermore the lid of Garbuzov is inherently "suitable for printing information thereon". A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. Claims 48-50 and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garbuzov.

Garbuzov discloses the claimed invention except for the flexible membrane surrounding the sidewall being PVC. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use PVC for the flexible membrane of Garbuzov, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 49, 50, 63 and 64, Garbuzov discloses the claimed invention except for the flexible membrane surrounding the sidewall being less than 10 mils thick or between 5-10 mils thick. It would have been an obvious matter of design choice to make the flexible membrane of Garbuzov less than 10 mils thick or between 5-10 mils thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

10. Claims 52-55 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garbuzov in view of Fisher and Tepper.

Garbuzov discloses the claimed invention; especially the container being inflatable by pumping air into the nozzle. However, it is unclear if the air pump is external or integral to the container. Fisher teaches that it is known in the art to provide an air pump that is external and integral to an analogous container. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the inflatable container of Garbuzov with the air pump of Fisher, in order to inflate the container.

Regarding claims 55 and 69, Garbuzov discloses the claimed invention; especially the container being inflatable by pumping air into the nozzle. However, Garbuzov does not disclose the air pump being an bellow-type air pump. Tepper teaches that it is known in the art to use a bellow-type air pump to inflate an analogous container. It would have been obvious to a person having ordinary skill in the art at the



time the invention was made to provide the inflatable container of Garbuzov with the bellow-type air pump of Tepper, in order to inflate the container.

11. Claims 37-50 and 56-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Brown.

Walker discloses the claimed invention except for the sidewall being surrounded by a flexible plastic membrane. Brown teaches that it is known in the art to provide a flexible membrane surrounding the sidewall of an analogous cooler. It would have been obvious to surround the sidewall of Walker with the flexible membrane of Brown, in order to protect the inflatable cooler. Furthermore, Brown discloses shaping the flexible membrane such that its diameter is less than that of the sidewall it surrounds. The smaller diameter of the Brown flexible membrane inherently provides support for stress normal to the sidewall it protects.

Regarding claims 38 and 59, the printed matter disclosed by Brown is considered to be broad enough in scope to comprise one of text, graphics and logos.

Regarding claim 44, the lid of Walker is considered to be a "smooth top" to the same degree as claimed. Furthermore the lid of Walker is inherently "suitable for printing information thereon", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 39, Walker and Brown disclose the claimed invention, as discussed above, except for the printing silk-screened or vinyl graphically printed. It would have been an obvious matter of design choice to silk-screen or vinyl graphically print the information of Brown, since applicant has not disclosed that silk-screening or vinyl graphic printing solves any stated problem or is for any particular purpose and it appears that the Brown invention would perform equally well with the information being silk-screened or vinyl graphically printed.

Regarding claims 41, 57 and 58, Walker and Brown disclose the claimed invention except for the container being cylindrical, pyramidal or conical shaped. It would have been an obvious matter of design choice to make the container Walker cylindrical, pyramidal or conical shaped or whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding claims 37, 48, 56 and 62, Walker and Brown disclose the invention as claimed except for the flexible membrane surrounding the sidewall being plastic PVC. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use PVC for the flexible membrane of Brown, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 49, 50, 63 and 64, Walker and Brown disclose the claimed invention except for the flexible membrane surrounding the sidewall being less than 10 mils thick or between 5-10 mils thick. It would have been an obvious matter of design choice to make the flexible membrane of Brown less than 10 mils thick or between 5-10 mils thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

12. Claims 51-55 and 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Brown, as applied to claims 37, 53 and 55, and in further view of Fisher and Tepper.

Walker discloses the claimed invention; especially the air chambers being inflatable through valves. However, it is unclear if inflation is by breathing into the valve or by an air pump that is external or integral to the container. Fisher teaches that it is known in the art to inflate analogous air chambers by breathing into the valves or provide an air pump that is external and integral to the analogous container. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to inflate the air chambers of Walker by breathing or with the air pump of Fisher, in order to inflate the container.

Regarding claims 55 and 69, Walker discloses the claimed invention; especially the air chambers being inflatable valves. However, Walker does not disclose inflating the air chambers with a bellow-type air pump. Tepper teaches that it is known in the art to use a bellow-type air pump to inflate the air chambers of an analogous container. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to inflate the air chambers of Walker with the bellow-type air pump of Tepper, in order to inflate the container.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 37-69 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

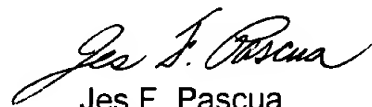
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



Jes F. Pascua  
Primary Examiner  
Art Unit 3727

JFP